

### **REMARKS/ARGUMENTS**

Reconsideration and withdrawal of the rejections set forth in the Non-Final Office Action dated June 8, 2009 are respectfully requested in view of the arguments and amendments presented herein.

This amendment is timely filed in view of an extension of time submitted herewith.

#### **Status of the Claims**

In the present response, claim 49 is amended, claims 52 and 57 were previously cancelled, and claims 61-70 are added. Therefore, claims 49-51, 53-56, and 58-70 are pending in the application with claim 49 being the sole independent claim.

#### **Explanation, Support, and Entry of Amendment**

By this amendment, Applicants add new independent claim 61 to recite, inter alia, that the system comprises a thermal cycling device consisting of only one sample block for receiving the sample well tray.

Applicants submit that each of the foregoing amendments is fully supported by the specification. For the convenience of the Office, specific examples of support are noted below:

Support for the amendment to recite a thermal cycling device consisting of only one sample block is found, e.g., in previously pending claim 57 and in Fig. 5 of the present application. New dependent claims 62-70 correspond to the previously pending dependent claims.

Accordingly, no new matter has been added by the amendments.

#### **Disclosure Statement**

Applicants again note that the July 2, 2008 Office Action included a copy of the Form PTO 1449 from the September 27, 2004 Information Disclosure Statement in which the two foreign patent documents were crossed-through. These foreign patent documents are in Japanese. Applicants, however, note that this Information Disclosure

Statement included an English language version of an office action issued by the Japanese Patent Office in which these foreign patent documents were discussed.

The present Office Action included a copy of the Form PTO 1449 from the September 27, 2004 Information Disclosure Statement in which the two foreign patent documents were again crossed-through. No further explanation was provided by the Office.

In view of the English language version of the office action issued by the Japanese Patent Office, Applicants again request that the Examiner send Applicants an initialed copy of the Form PTO 1449 (i.e., in which the documents are not crossed-through) in the next communication from the U.S. Patent and Trademark Office, so that the Examiner's consideration of the disclosure statement is clearly reflected in the record. Otherwise, Applicants respectfully request further explanation as to why these documents were crossed-through.

### **Response to § 102 Rejection**

Claims 49-51, 53-56, and 58-60 are rejected under 35 U.S.C. § 102(b) as anticipated by Suzuki et al. (U.S. Patent No. 4,981,801). The Office asserts, "Suzuki discloses a system comprising a thermal cycling device (fig. 7, ref. 71-75) having a sample block with a plurality of openings for receiving a sample well tray (88) . . . ." Office Action at page 2.

In response to Applicants' previous arguments, the Office asserts that "'comprises' language is open ended claim language which allows for more than one sample block to exist in the prior art." Id. at page 3. The Office Action states, "The Examiner designates only one of the sample blocks of the prior art as the only one sample block of the instant application." Id. (emphasis in original) The Office Action further states that "[i]f Applicant requires 'only one' sample block then the claim language needs to include 'consisting' instead of 'comprising.'" Id.

In response, Applicants respectfully submit that the relied on disclosure of Suzuki fails to disclose a system for manipulating and thermal cycling a sample well tray, comprising only one sample block for receiving the sample well tray. In contrast, the relied on disclosure of Suzuki involves a system having a plurality of sample blocks.

Suzuki states, "In the reaction unit, five thermostats 71 to 75 and one stage 76 are arranged." Suzuki at col. 11, lines 22-23. As noted above, the Office asserts that thermostat 72 is a sample block. Suzuki further states, "In this embodiment, as shown in FIGS. 8 to 10 in detail, a rack 88 for holding one hundred reaction vessels 87 in a matrix is successively transported between the thermostats 71 to 75 so as to effect the desired reaction." Id. at col. 11, lines 49-53. The relied on embodiment of Suzuki therefore involves five sample blocks 71 to 75. Thus, the relied on disclosure of Suzuki fails to disclose a system for manipulating and thermal cycling a sample well tray, comprising only one sample block for receiving the sample well tray.

Applicants respectfully submit that although "comprising" language generally allows the presence of other elements, it cannot be used to ignore the plain meaning of "only one." In this regard, Applicants respectfully submit that a skilled artisan would understand that "only one sample block" means that only one sample block can be present. Since Suzuki discloses a system having five sample blocks, Applicants respectfully submit that the broadest reasonable interpretation of Suzuki cannot ignore the other sample blocks of Suzuki.

In view of the above, Applicants respectfully request withdrawal of this ground of rejection.

### **New Claims**

For reasons similar to those discussed above, Applicants respectfully submit that new claims 61-70 are also in condition for allowance.

## **CONCLUSION**

In view of the foregoing, Applicants submit that all outstanding issues in this case have been resolved, and that all pending claims in their current form are allowable. A Notice of Allowance is therefore respectfully requested. Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 50-3994.

If a telephone conference would expedite the prosecution of the subject application, the Examiner is requested to call the undersigned at (650) 554-3414.

Respectfully submitted,

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